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Final

than the inner diameter of said tubular member, said inner beveled surface being arranged to engage said sealing bead and form a seal, said rounded outer profile is arranged to engage said beveled surface, and said fitting is movable between a first position, in which a non-sealing condition exists and said gasket is in its relaxed condition, and a second position, in which a sealing condition exists and said inner diameter of said gasket is equal to said inner diameter of said tubular member.

#### REMARKS

The indication by the Examiner of allowable subject matter in claims 21 and 22 is gratefully acknowledged. By the present amendment, claim 21 has been rewritten in independent form incorporating all of the limitations of claim 19. Accordingly, claims 21 and 22 are now allowable.

The applicant continues to believe that claims which use the term "substantially equal" encompass the species in which the diameters are equal and, therefore, that the restriction requirement was improper. In view of this, in order to obtain a resolution of the issue, the applicant is submitting a Petition from Requirement for Restriction under 37 C.F.R. 1.144 at the time of filing this Amendment. The applicant's position on this issue is presented in more detail in the Petition, and the Examiner is encouraged to consider the presentation of the issue in the Petition. If the Examiner were to agree with the applicant after considering the more-detailed presentation of the Petition and were to consider claims 1-11, 15, 16 and 18, the need for review of the Petition on the merits by the Group Director would be avoided.

A Notice of Appeal has been filed with the present Amendment to avoid the expense of extensions of time if the Examiner maintains his position that the restriction requirement is proper, that claims 1-11, 15, 16 and 18 will not be considered and that claims 19, 20 and 23 are not allowable.

In commenting on the rejection of claims 19 and 20 on the ground of obviousness-type double patenting over claims 1, 6 and 9

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of the '747 patent, the Examiner stated that it is immaterial whether the patented claims recite more structural features than is presently being claimed. Ordinarily this is true. However, in the present case, this is not true. Previous applications for the more-basic invention represented by claim 19 of the present application were filed before the application on which the '747 patent is based. The application on which the '747 patent is based was filed on May 1, 1991. Serial No. 07/652,225, which was directed to the invention represented in present claim 19 and of which the present application is a CIP, was filed on February 6, 1991. Furthermore, that application was a continuation of Serial No. 07/392,460, filed on August 11, 1989. Thus, applications directed to the more-basic invention were filed and claims directed to the more-basic invention were pending before the filing of the application on which the '747 patent is based. In resolving the problem presented by this situation, the courts have reasoned that the order of issuance should be disregarded in this special situation and the later issuing generic patent should be upheld if the improvement is patentably distinct from the generic invention. Please see Patents, Donald S. Chisum, Section 9.03[2][c], a copy of which is submitted herewith. Please also refer to In re Borah and In re Stanley, which are cited in footnote 49 of the submitted section.

Thus, in the present case, the fact that the patented claims recite more structural features than the pending claims is material. Claim 1 of the '747 patent calls for an outer section having an axial dimension which limits compression of the sealing bead beyond its elastic limits by engagement with the radial end wall. Claim 6 of the '747 patent calls for the gasket to have an outer section having an axial dimension which limits the axial movement of the gasket with respect to the tubular members to a predetermined distance which is less than the amount which would cause one of the sealing beads to be stressed beyond its elastic limit. Claim 9 of the '747 patent calls for axial dimensions of the sealing bead to be selected to correspond to the axial depth of

the beveled faces so that no space is left between the radially inner side of the gasket and each rectilinear profile when the outer section of the gasket engages the radial end walls of the tubular member. Each of claims 1, 6 and 9 of the '747 patent distinguish patentably over claims 19 and 20 of the present application in view of at least the distinguishing limitations described above. In view of this, the double patenting rejection set forth in the final rejection is inappropriate and should be withdrawn.

The rejection of claim 23 on the ground of obviousness-type double patenting is inappropriate for the same reasons. The Leigh reference cited by the Examiner does not suggest the limitations described above of claims 1, 6 and 9 of the '747 patent which are missing from claim 23.

With respect to the rejection of claim 23 under 35 U.S.C. 102 as being anticipated by PCT '3495, the applicant again points out that the specific tightening step of claim 23 is not disclosed in the PCT reference. It appears to be the Examiner's position that such a tightening step is inherent in the PCT reference. More specifically, the Examiner states that the end formations of the fitting of the PCT reference act to center the gasket and that the end formations may engage the beveled surface of the gasket before the plane coronal parts come into contact. The applicant points out that the engagement of the beveled surface before the plane coronal parts come into contact is the mechanism by which the end formations of the fitting act to center the gasket. Such engagement does not enable tightening as specified in claim 23. If the end formations of the fitting of PCT '3495 engage a portion of the beveled surface, that portion is radially too far inward, and the gasket is not centered. At the same time, the diametrically opposed portion of the beveled surface lies radially outward farther than it should. The engagement on the first portion of the beveled surface cams the gasket radially outward on the first side, bringing the opposite side radially inward and, thus, centering the gasket. Since the beveled surfaces of the end portions fit within

the beveled surface of the gasket when the gasket is centered, the inner diameter of the gasket is not enlarged upon tightening, as is called for by claim 23. Tightening beyond the condition shown in Fig. 2 of the PCT reference will result in the portions of the annular beads engaging the surfaces 23 and 23' of the gasket, which will tend to enlarge the inner diameter of the gasket radially inward.

In the present invention, even when the gasket is centered, the beads engage the beveled surfaces, and they do so before they can engage the radially inward portion of the gasket. As a result, tightening beyond the condition in which the beads just engage the beveled surfaces causes the gasket to deform radially outward and causes the inner diameter of the gasket to increase. Thus, the PCT reference does not anticipate claim 23 under 35 U.S.C. 102.

The Examiner continues to reject claims 19, 20 and 23 under 35 U.S.C. 103 as being unpatentable over Leigh '597 in view of White. There appears to be no response to the applicant's arguments concerning this rejection. These arguments were presented in an Amendment filed in parent application, Serial No. 07/392,460 on July 2, 1990. It appears that the Examiner has not commented on the applicant's arguments at any time. In view of the Examiner's continuing rejection on this ground, it is assumed that the Examiner found the arguments in the 1990 response to be unpersuasive, but it is not known why they were unpersuasive.

It is submitted that all of the claims in the application are allowable and that the application is in condition for allowance. A notice to that effect is respectfully requested.

Respectfully submitted,

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It seems clear that *Allen*, like the *Sarett* case,<sup>45</sup> is inconsistent with earlier decisions of the Court of Customs and Patent Appeals and its later development of the concept of "obviousness" type double patenting and the effect of a terminal disclaimer.<sup>46</sup> It can therefore be dismissed as a transitional aberration. In *In re Schneller* (1968),<sup>47</sup> the court held that an applicant who had obtained patents on combinations BCX and ABCX could not obtain subsequent patents on ABCY and ABCXY, particularly since the earlier patent claims were "open" and would encompass ABCXY.

**[c]—Generic Claim Issuing After Later Filed Specific or Improvement Claim.** An inventor may first file an application for a patent claiming a basic or generic invention and thereafter file a patent on an improvement on that basic invention. The broader basic patent may face greater difficulty in the Patent Office examination process with the result that a patent on the improvement issues first. The question then arises whether a second patent on the broader generic invention is barred by double patenting. Under general principles of patentability, an earlier specific patent anticipates a later generic one.<sup>48</sup> Further, to allow such a patent will extend the inventor's period of monopoly over the improvement disclosed and claimed in the first patent. On the other hand, to deny a patent may be unfair to the applicant who does not have complete control over the rate of progress of an application through the Patent Office.

In resolving the problem, the courts reasoned in effect that the order of issuance should be disregarded in this special situation and the later issuing generic patent should be upheld if the improvement is patentably distinct from the generic invention.<sup>49</sup> The effective peri-

<sup>45</sup> See § 9.03[2][b][ii] *supra*.

<sup>46</sup> See § 9.03[3] *infra*.

<sup>47</sup> 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

<sup>48</sup> See § 3.02[2] *supra*.

<sup>49</sup> *In re Borah*, 354 F.2d 1009, 148 USPQ 213 (CCPA 1966); *In re Stanley*, 214 F.2d 151, 102 USPQ 234 (CCPA 1954); *Thomson-Houston Elec. Co. v. Ohio Brass Co.*, 80 F. 712 (6th Cir. 1897); *Thomson-Houston Elec. Co. v. Elmira & H. Ry.*, 71 F. 396 (2d Cir. 1896), *cert. denied*, 163 U.S. 685 (1896).

See generally Richardson, "Double Patenting and Generic Claims in a Later Issuing Patent," 45 J. Pat. Off. Soc'y 451 (1963); Note, "Double Patenting Where a Generic Patent Is Issued After a Species Patent," 19 Geo. Wash. L. Rev. 505 (1951).

od of monopoly is no more extended as to the improvement than if the improvement had issued after the generic patent. This rule does not apply if the later issuing generic claim is filed after the application for the improvement<sup>50</sup> or if the applicant inexcusably causes delay in the issuance of the generic claim.<sup>51</sup>

In *Miller v. Eagle Manufacturing*, the Supreme Court invalidated a second patent that could be construed as generic one.<sup>52</sup> However, in the leading case of *Thomson-Houston Electric Co. v. Ohio Brass* (1897),<sup>53</sup> Judge Taft distinguished *Miller v. Eagle* as involving an attempt to obtain two patents for the same device discharging different functions. In *Ohio Brass*, the patent in question for suspended switches for electric railways issued April 1, 1890, on an application filed March 12, 1887. A patent on an improvement on the basic invention issued February 5, 1889, on an application filed November 12, 1888. The defendant argued that the second generic patent should be invalid because its effect otherwise would be to extend the statutory period of monopoly on the improvement. Judge Taft rejected this argument.

“Since the case of *O'Reilly v. Morse* . . . it has been well settled that a patent may issue for an improvement on an earlier invention either to the original inventor or to a stranger. Of course, no one can use the improvement without right or license to use the fundamental invention; but, on the other hand, the right to use the original invention does not confer the right to use the improvement without license from the tributary inventor. We do not understand this general doctrine to be denied, but it is said that if, by some chance, the application for the fundamental patent is delayed in

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<sup>50</sup> *In re Blattner*, 245 F.2d 491, 114 USPQ 299 (CCPA 1957); *Union Typewriter Co. v. L.C. Smith & Bros. Typewriter Co.*, 181 F. 966 (3d Cir. 1910); *Morse Chain Co. v. Link Belt Mach.*, 164 F. 331 (7th Cir. 1908).

See also U.S. Patent & Trademark Office, *Manual of Patent Examining Procedure* § 806.04(i) (4th ed. 1979): “Where an applicant has separate national applications for plural species, but presents no generic claim until after the issue of a patent for one of the species, the generic claims cannot be allowed, even though the applications were pending.”

<sup>51</sup> *Pierce v. Allen B. Du Mont Labs., Inc.*, 297 F.2d 323, 131 USPQ 340 (3d Cir. 1961), *cert. denied*, 371 U.S. 814, *reh'g denied*, 371 U.S. 917 (1962).

<sup>52</sup> See § 9.02[6] *supra*.

<sup>53</sup> 80 F. 712 (6th Cir. 1897).

its course through the patent office until a patent on the avowed improvement has issued, then the patent on the improvement on the fundamental invention is void. In cases where the delay in the issuing of the patent for the main invention cannot be charged to the laches or fraud of the patentee, such a rule would be a hard one; and unless it is required by the express words of the statute, or by the express holding of the supreme court, we should be inclined, if possible, to avoid declaring it to exist.”<sup>54</sup>

He noted the reasons why a generic patent may issue after an improvement patent.

“The fact that a patent for an improvement may expire before the patent for the main invention is the result of several circumstances,—one that a patent may be taken out for an improvement on a patentable invention, another that there is no limitation by statute upon the time within which a patent may issue upon an application after it is filed, provided the applicant is not guilty of violating the two years’ restriction imposed by the statute, and a third that the course of an application for a generic or broad invention may legitimately take longer in its course through the patent office than a comparatively unimportant improvement on that invention.”<sup>55</sup>

The *Ohio Brass* rule does not mean that two patents can be upheld simply because the more general patent was “first-in, last out.” The assumption is that the first patent is an improvement independently patentable over the generic invention.<sup>56</sup> A point not made clear in *Ohio Brass* is which patent should be invalidated if it is determined that in fact there is no such patentable distinction. Some language in Judge Taft’s opinion seems to indicate that it would be the first

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<sup>54</sup> 80 F. at 724.

<sup>55</sup> 80 F. at 727.

<sup>56</sup> See § 9.03[2][b][ii] *supra*.

See also *Norris Indus., Inc. v. Tappan Co.*, 599 F.2d 908, 203 USPQ 169 (9th Cir. 1979) (“Tappan urges this Court to consider its good faith in applying for a patent for its generic device first and then for its ‘improvement.’ The delay in issuing the patent for the original product was caused by the Patent Office, not by Tappan. These assertions simply do not alter the District Court’s findings that the two patents are ‘not patentably distinct.’”).

patent.<sup>57</sup> If that rule were adopted, the validity of the second patent would be upheld without an inquiry into whether the improvement is separately patentable. However, such a rule makes little sense. The Patent Office would be in the unusual position of issuing an improvement patent which may or may not be valid—depending on whether the inventor is successful in obtaining a second patent on the generic invention. The Court of Customs and Patent Appeals appears to assume that absence of a patentable distinction precludes issuance of the second generic patent without an effective terminal disclaimer.<sup>58</sup>

In *Sarkisian v. Winn-Proof Corp.* (1978),<sup>58.1</sup> the District Court of Oregon adopted the unique position that the claims of a second issuing generic patent as to which the applicant had filed a terminal disclaimer were partially invalid to the extent that they covered embodiments within the claims of the first issuing specific patent. Plaintiff

<sup>57</sup> 80 F. at 724:

"Now, it is not material to this discussion whether these improvements are patentable or not. They are expressly claimed as improvements, and no attempt is made by the patentee to cover anything but them. If inventions at all, then they are separable from the old switch and trolley combinations, and, if they are not inventions, the patents are void, and cover nothing."

<sup>58</sup> *In re Borah*, 354 F.2d 1009, 1015-18, 148 USPQ 213 (CCPA 1966); *In re Asseff*, 173 F.2d 253, 81 USPQ 112 (CCPA 1949):

"If the generic claims here on appeal presented matter patentable over the patent claims of appellant when viewed in connection with the other patents cited as references, the fact that they are embraced in a second application, which is a continuation in part of the first application, would not militate against their allowance, the respective applications having been copending, but unhappily for appellant we are unable to agree that such patentability exists."

See also *Sarkisian v. Winn-Proof Corp.*, 203 USPQ 60 (D. Ore. 1978), *rev'd, on other grounds*, 697 F.2d 1313, 217 USPQ 702 (9th Cir. 1983), *cert. denied, sub nom. Carsonite Int'l Corp. v. Carson Mfg. Co., Inc.* 460 U.S. 1052 (1983).

In *Suffolk Mfg. Co. v. Hayden*, 70 U.S. (3 Wall.) 315, 18 L. Ed. 76 (1866), the Supreme Court indicated that "the last, not the first is void" in a double patenting situation. See § 9.02[1] *supra*.

See also *In re Hession*, 296 F.2d 930, 132 USPQ 40 (CCPA 1961) (assignee and successors bound by election to take patent in name of one assignor who was not in fact the first inventor).

<sup>58.1</sup> 203 USPQ 60 (D. Ore. 1978), *rev'd*, 697 F.2d 1313, 217 USPQ 702 (9th Cir. 1983), *cert. denied, sub nom. Carsonite Int'l Corp. v. Carson Mfg. Co., Inc.* 460 U.S. 1052 (1983).

obtained two patents on a certain sign stand device. In the first to issue (696), the claims covered only devices with “preloaded coiled springs.” In the second to issue (482), the claims covered devices with “spring means” (which include both preloaded coil springs and other types such as flat springs). The court ruled that the terminal disclaimer was effective to preclude a double patenting invalidation of the second patent *except* that “to the extent that the claims [of the second patent] purport to cover . . . an embodiment [within the claims of the first patent], the [second] patent must be declared void.” The court cited no authority for its ruling but thought that it had “no practical significance in this case because the 696 [first] patent covers this embodiment already, and the plaintiff had already disclaimed any time extending beyond the termination date of the 696 patent.” However, the court’s ruling does deprive the plaintiff of potential protection should the first patent be ruled invalid on some technical ground.<sup>58.2</sup>

On appeal in *Sarkisian*, the Ninth Circuit reversed, holding that a terminal disclaimer obviated any double patenting problem where the two patents involve an obvious variation rather than a complete overlap of claims.<sup>58.3</sup>

**[d]—Patents with Identical Issue Dates.** If two or more patents issue on the same date, they will expire simultaneously.<sup>59</sup> Hence with such patents, a primary concern behind the doctrine of double patenting—extension of the statutory period of monopoly—does not apply. However, simultaneous issuance does not remove the concern that issuance of separate patents for the same invention or closely-related inventions creates the possibility of a multiplicity of suits or harassment against an alleged infringer.

In *Underwood v. Gerber* (1893),<sup>60</sup> the Supreme Court invalidated one patent, relying in part on a patent to the same inventors with a lower number issued the same day. The Court did not discuss the effect of simultaneous issuance and in parts of the opinion it assumes that the first patent is prior art as to the second, a view that clearly

<sup>58.2</sup> See § 9.04[2][b][v], [3] *infra*.

<sup>58.3</sup> 697 F.2d 1313, 217 USPQ 702 (9th Cir. 1983).

<sup>59</sup> See § 16.04 *infra*.

<sup>60</sup> 149 U.S. 224, 37 L. Ed. 710, 13 S. Ct. 854 (1893), discussed at § 9.02[5] *supra*.